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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Hearing:  
October 10, 2001

Paper No. 13  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Joe Driskill, Jr.

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Serial No. 75/580,063

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Thomas F. Harkins, Jr. of Whitaker, Chalk, Swindle &  
Sawyer, L.L.P. for Joe Driskill, Jr.

William Breckenfield, Trademark Examining Attorney, Law  
Office 112 (Janice O'Lear, Managing Attorney).

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Before Wendel, Bottorff and Drost, Administrative Trademark  
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the product configuration mark depicted below

for goods identified in the application as "musical instruments, namely guitars."<sup>1</sup>

The Trademark Examining Attorney has issued final refusals of registration on two grounds. First, he has refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark is confusingly similar to the mark depicted below,

previously registered<sup>2</sup> for goods identified as "musical instruments, namely guitars and basses, and parts

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<sup>1</sup> Serial No. 75/580,063, filed October 30, 1998. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), with October 1997 being alleged as the date of first use anywhere and the date of first use in commerce. The following "description of mark" statement appears in the record: "The mark consists of the design of a body shape of guitars and basses as illustrated in solid lines in the drawing. The dotted lines are for illustrative purposes only and form no part of the claimed mark." (October 24, 2000 Request for Reconsideration, Exhibit O.)

<sup>2</sup> Registration No. 1,509,200, issued October 18, 1988. Affidavits under Sections 8 and 15 accepted and acknowledged. The registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f), and the following "description of mark" statement: "The mark consists of the body shape of guitars and basses in all three dimensions as illustrated in solid lines."

therefor." Second, he has refused registration on the ground that the matter applicant seeks to register fails to function as a mark because it consists merely of the non-distinctive configuration of applicant's goods, see Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, which has not acquired distinctiveness as a mark and thus is not registrable under Trademark Act Section 2(f), 15 U.S.C. §1052(f).

Applicant has appealed both of the Trademark Examining Attorney's final refusals. The appeal has been fully briefed, and an oral hearing was held at which applicant, appearing pro se, and the Trademark Examining Attorney presented arguments. After careful consideration of all of the evidence and arguments, we affirm both refusals.

We turn first to the non-distinctiveness refusal. Initially, and as a matter of law, we find that applicant's guitar configuration, like any product configuration, is not inherently distinctive and that it thus is unregistrable on the Principal Register absent a showing of acquired distinctiveness. See *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000) [54 USPQ2d 1065]; *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279, 1282-83 (TTAB 2000). Applicant's counsel's arguments to the contrary are not persuasive. Thus, the issue to be

determined is whether the product configuration applicant seeks to register has acquired distinctiveness and thus is registrable on the Principal Register pursuant to Section 2(f).

To establish acquired distinctiveness, applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the producer. Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.

*Id.*, 56 USPQ2d at 1283.

Applicant bears the burden of establishing, *prima facie*, that the matter it seeks to register has acquired distinctiveness as a mark. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1576, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). That burden is a relatively high one in cases involving product configurations, *see In re Ennco Display Systems, Inc.*, *supra*, 56 USPQ2d at 1284, and we find that applicant has failed to carry the burden in this case.

Looking first at the circumstantial evidence pertaining to acquired distinctiveness, we note that applicant has marketed guitars having the configuration applicant claims is his trademark for less than five years. Thus, the provision in Section 2(f) that "[t]he Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" is not applicable here. Additionally, we note that applicant's guitars all bear the mark DRISKILL prominently on their headstocks.

There is no evidence in the record as to the extent of applicant's sales of goods under the alleged mark, either in terms of dollars or units. There likewise is no evidence as to the amounts applicant has expended in advertising and promoting his goods under the alleged mark. Moreover, for the reasons discussed below, we are not persuaded that applicant's advertising and promotional materials and activities, as they have been described in applicant's request for reconsideration and the exhibits thereto, have resulted in consumer recognition of the configuration of applicant's guitar body, per se, as a

source-indicating trademark. See, e.g., *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983); TMEP §1212.06(b).

Applicant, in support of his acquired distinctiveness claim, relies on the photograph of his guitar which appears, directly beneath the wording "Driskill Guitars," on the Internet home page of the popular singer Shania Twain. (Applicant's Request for Reconsideration, Exhibit D.) Even assuming, as applicant contends in his request for reconsideration, that millions of Shania Twain fans see this advertisement for applicant's guitars when they visit her web page, we see nothing in the advertisement itself which would support a finding that consumers would view the configuration of the body of applicant's guitar as applicant's trademark. Rather, the photograph of the guitar would likely be perceived merely as that, i.e., a photograph of applicant's goods. The same goes for the photographs of applicant's guitars which appear in the other exhibits to the request for reconsideration, i.e., in the 2000-2001 Guitar World Buyer's Guide (Exhibit F), the December 2000 Guitar World product review (Exhibit G), the August 2000 article in Fort Worth magazine (Exhibit I), and

the August 9, 1999 article from The Dallas Morning News (Exhibit K).<sup>3</sup>

In this regard, the present case is distinguishable on its facts from *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, *supra*, in which the applicant therein was attempting to prove that the shape of the peg head of its guitar, per se, had acquired distinctiveness. The record in that case included evidence (from the testimony of experts and from treatises on guitars) sufficient to prove that guitarists were accustomed to looking to the shape of a guitar's peg head, per se, as a source-indicating "signature." Based on such evidence of the "folkways" of guitarists, the Board found that the applicant's advertisements which included photographs of the peg head served, "albeit modestly," as probative evidence of

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<sup>3</sup> This article from The Dallas Morning News was not about applicant or his guitars, but rather was based on an interview with a local businessman on the subject of retirement planning. In a photograph accompanying the article, depicting the businessman (who is one of applicant's guitar customers) in his office, one of applicant's guitars is hanging on the office wall. In his request for reconsideration, applicant asserts as follows: "The exciting news for me is the numerous amounts of telephone calls that I received advising that the caller had immediately recognized the guitar shape hanging on the wall as a Driskill. I found this to be particularly satisfying, as there was no mention of the guitar in the news article." Given the hearsay nature of this assertion, and the absence in any event of details as to the number of such callers and the nature of their relationship to applicant, this article and applicant's assertions with respect thereto are entitled to very little probative value as evidence on the issue of acquired distinctiveness.

acquired distinctiveness. 231 USPQ at 934. In contrast, no evidence is of record in this case from which we could conclude that guitarists typically or generally look to the shape of a guitar body, per se, as a source-indicator. In view thereof, we accord little probative value to the fact that applicant's advertising and promotional materials include photographs of applicant's guitars. These photographs are likely to be perceived by purchasers merely as informational depictions of the ornamental and/or functional features of applicant's guitars.

Applicant also relies on the fact that his advertisement on Shania Twain's website serves as a link to applicant's own website, which features more photographs of, and information about, applicant's guitars. Similarly, applicant relies on the fact that persons using various web search engines who enter "Driskill" or "Driskill Guitars" are able to link to applicant's website. However, even assuming the truth of applicant's assertion that he has had 40,000 hits on his website, we find, based on the printouts from the actual website which applicant has made of record, that there is nothing in the content of applicant's website which would lead customers to recognize the shape of applicant's guitar body, per se, as applicant's trademark.



Specifically, the mere photographs of applicant's guitars depicted on the website do not suffice as evidence of acquired distinctiveness, for the reasons discussed above. Further, nothing in the text appearing on the website informs or even suggests to purchasers that the shape of applicant's guitar body, per se, is intended to function as a trademark, and there is no basis in the record for inferring that purchasers viewing the website would perceive or assume such trademark significance on their own. There is no text in applicant's website advertisements (nor in any of the articles, product reviews or other materials applicant relies on) which stresses, or even mentions, the trademark significance of the guitar body shape. In this regard, this case is readily distinguishable from *In re Ovation Instruments, Inc.*, 201 USPQ 116 (TTAB 1978), upon which applicant relies.<sup>4</sup> See also *In re Ennco Display Systems Inc.*, *supra*, 56 USPQ2d at 1285, and cases cited therein.

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<sup>4</sup> We acknowledge that the Board deemed the applicant in *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, *supra*, to have established the acquired distinctiveness of its guitar peg head shape despite the absence of "look for" advertising of the type found in *Ovation*. Again, however, that result was premised on the existence in the record of evidence which established that guitarists already were accustomed to look to the shape of the peg head as a source-indicator, as well as evidence of the applicant's substantial sales and advertising expenditures. Equivalent evidence is lacking in this case.

Indeed, the only mention of the shape of the guitar body in the text of applicant's website (or in any of the printed materials applicant has made of record) is a reference to the functional and ornamental features and advantages of the guitar body's shape: "The body shape is not only killer looking but also causes the guitar to be perfectly balanced. Sit it on your lap, take your hands off and it stays right there! This balance also makes it very comfortable to play while standing for long periods of time." (See applicant's specimen brochures, and the printout from applicant's website at Exhibit D to the request for reconsideration.) In this context, that single reference to the guitar body shape as being "killer looking" would be perceived by purchasers merely as a laudatory reference to a feature of the guitar itself, i.e., the ornamental or aesthetic desirability of the design. These explicit references by applicant to the functional and ornamental advantages of the guitar body's shape do not support a finding that purchasers would view the shape, per se, as a source-indicator; rather, they weigh against such a finding.<sup>5</sup> See, e.g., *In re Ennco*

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<sup>5</sup> In his first office action, the Trademark Examining Attorney refused registration on the ground that applicant's configuration mark is de jure functional. That refusal was subsequently withdrawn, and the functionality of applicant's configuration is not at issue here.

*Display Systems, Inc., supra*, 56 USPQ2d at 1285; *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 662, 36 USPQ2d 1065, 1070-71 (7<sup>th</sup> Cir. 1995).

Applicant also asserts, in his request for reconsideration, that T-shirts imprinted with the Driskill name and the guitar body shape design are "now available," and that his business stationery "has been revised" to include depictions of the guitar body shape. (See Exhibit J to applicant's request for reconsideration.) However, this evidence is entitled to little probative value on the issue of acquired distinctiveness, inasmuch as applicant's distribution of these items appears to be of relatively recent origin, and because we cannot determine from the record the scope and effect of such distribution. Applicant contends that the T-shirts "are being sent to guitarists all over the world" and that he has "received numerous comments from customers on satisfaction with the new [business] forms." In our view, these statements fail to establish that the T-shirts and stationery have had any appreciable effect on purchasers' perception and recognition of the guitar body shape as a source-indicating trademark.

Applicant's remaining proffered circumstantial evidence likewise fails to persuade us that applicant's

guitar body shape has acquired distinctiveness. Applicant's listing in the 5<sup>th</sup> Edition of the Blue Book of Electric Guitars (Exhibit H to request for reconsideration) includes neither a depiction nor a discussion of the shape of applicant's guitar body, and it thus is of no probative value on the question of acquired distinctiveness. The fact that both Shania Twain's lead guitarist and Billy Gibbons of the band ZZ Top have test-played and been satisfied with applicant's guitars (Request for Reconsideration at 8) is not probative evidence of the acquired distinctiveness of the guitar body shape, per se. The pleadings and other papers from applicant's Texas state court civil action against a third-party competitor do not establish that the guitar body shape has acquired distinctiveness. *In re Ennco Display Systems, Inc., supra*, 56 USPQ2d at 1286; *In re The Original Red Plate Co.*, 223 USPQ 836, 839 (TTAB 1984). Finally, the incident recounted in the Fort Worth magazine article, about a theft of one of applicant's guitars and its recovery from a pawn shop, is not probative on the issue of acquired distinctiveness, and it is hearsay in any event.<sup>6</sup>

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<sup>6</sup> The article states: "Joe's excited today because one of his guitars, stolen some time ago from a collector by a thief who took only the Driskill from the group, has been spotted at an area pawn shop." Applicant argues in his brief (at 12) that this incident is evidence of acquired distinctiveness because "(a) the

We look finally at applicant's direct evidence of acquired distinctiveness. This evidence consists of identical form statements which have been signed, according to applicant, by "professional and individual guitar players, national guitar parts businesses and suppliers, entertainers, and other professionals, as well as non-music individuals." (Request for Reconsideration at 5.) The first form statement includes a line drawing of applicant's guitar body shape as depicted in the application drawing, and it reads as follows:

I recognize this unique shape as a Driskill Guitar. This body shape is very unique and is instantly recognizable as a Driskill guitar. It is very distinctive and nothing else looks like it. It is a very original design and it is very novel and striking. This shape, being so unique, does NOT look like a Paul Reed Smith<sup>7</sup> or any other existing guitar. When I see it, I think of Driskill Guitars.

This statement, when signed by persons identified as music store personnel, includes the following additional

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thief recognized the Driskill in making the steal, and (b) the pawn shop owner recognized the Driskill to make the save." However, we see no basis for concluding that it was the configuration of applicant's guitar, per se, that enabled either the thief or the pawn shop owner to recognize the guitar as a "Driskill."

<sup>7</sup> The "Paul Reed Smith" is the guitar cited by the Trademark Examining Attorney as a Section 2(d) bar to registration of applicant's configuration. See *supra* at page 2.

language: "I am also aware that a large number of the customers here are aware of this body shape and recognize it as a Driskill Guitar body shape." The second form statement submitted by applicant also includes a line drawing of the guitar body shape, and reads as follows: "I recognize this shape as a Driskill Guitar. When I see it, I think of Driskill Guitars."

We find that these statements do not suffice to prove that applicant's guitar body shape, per se, has acquired distinctiveness as a source-indicating trademark. The probative value of the statements is limited by the fact that they are unsworn. *See, e.g., In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977); *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 31 USPQ2d 1481 (8<sup>th</sup> Cir. 1994). The circumstances under which the signatures were solicited and under which the statements were signed are not apparent from the record, further limiting the statements' probative value. The statements themselves are largely conclusory in nature, and to the extent that they may be read to assert that applicant's guitar body shape is inherently distinctive (e.g., "unique," "instantly recognizable," "distinctive," "original," "novel and striking"), they are unpersuasive as a matter of law under *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, *supra*.

Moreover, in view of the absence of evidence as to the extent of applicant's sales and advertising, the absence of evidence showing that applicant has promoted the guitar body shape, per se, as a trademark, and the absence of evidence showing that the relevant purchasers generally would look to guitar body shapes, per se, as source-indicators, the underlying factual basis for the conclusory opinions set forth in the statements is not apparent, and the probative value of the statements is lessened accordingly. Unlike the situation in *Ovation* and *Yamaha*, *supra*, where the customer and dealer affidavits and declarations were corroborated by, and indeed explained by, plentiful circumstantial evidence of acquired distinctiveness, no such corroborative circumstantial evidence exists in this case.

Thus, we have considered the statements submitted by applicant, but find that they, like applicant's various items of circumstantial evidence, are of limited probative value on the issue of acquired distinctiveness.

After careful consideration of all of the evidence of record, we find that applicant has failed to make out a *prima facie* case that his guitar body shape, per se, has acquired distinctiveness as a trademark. Therefore, we affirm the Trademark Examining Attorney's refusal to

register on the ground of non-distinctiveness. See Trademark Act Sections 1, 2, and 45, and Section 2(f).

We turn next to the Trademark Examining Attorney's Section 2(d) refusal based on the prior registration of the Paul Reed Smith guitar configuration mark. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's and registrant's goods are legally identical, i.e., guitars. In view of this legal identity of the goods, and in view of the absence of any restrictions in the identifications of goods in applicant's application and registrant's registration, we also find that the trade channels in which the goods move and the classes of customers to whom the goods are marketed are legally identical. See *Canadian Imperial Bank of Commerce*



*v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

These *du Pont* factors weigh in favor of a finding of likelihood of confusion.

Applicant argues that both his guitars and registrant's guitars are very expensive, costing several thousands of dollars, and that purchasers of these guitars accordingly constitute a "niche market" of careful, knowledgeable and sophisticated purchasers. However, inasmuch as applicant's goods are identified in the application merely as "guitars," we must presume, regardless of the nature of applicant's actual goods, that the goods encompass guitars of all types and in all price ranges, including relatively non-expensive guitars. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, *supra*; *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763 (TTAB 1986). We also must presume that potential purchasers are not necessarily particularly knowledgeable or sophisticated about guitars or about the trademarks under which they are marketed, nor are they necessarily particularly careful in making their purchasing decisions. In any event, "[t]he fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily

mean that they are immune from source confusion when similar marks are used in connection with related goods and/or services. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1998). Thus, we find that this *du Pont* factor, i.e., "the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful sophisticated purchasing," at best is neutral in this case, and that it does not weigh in applicant's favor.

The next *du Pont* factor to consider is "the number and nature of similar marks in use on similar goods." Applicant has submitted printouts of four third-party registrations covering guitar configurations,<sup>8</sup> but this evidence is of little probative value. Third-party registrations are not evidence that the registered marks are in use or that purchasers are aware of them. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *American Hospital Supply Corp. v. Air Products and Chemicals, Inc.*, 194 USPQ 340, 343 (TTAB 1977). Moreover, two of the registrations are on the Supplemental Register, and another has been cancelled under Trademark Act Section 7; these registrations are not evidence that the configurations depicted therein are

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<sup>8</sup> Registration Nos. 2,007,277, 2,215,791, 2,374,386 and 2,100,486.

functioning or perceived as trademarks. See *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744 (TTAB 1987); and TBMP §703.02(a). Finally, all of the guitar configurations depicted in the third-party registrations applicant has submitted are visually quite dissimilar to applicant's and registrant's guitar configurations. For all of these reasons, we find that the third-party registrations are not probative evidence of "similar marks in use on similar goods" for purposes of our likelihood of confusion analysis, and that this *du Pont* factor does not aid applicant in this case.<sup>9</sup>

Applicant contends that there have been no instances of actual confusion between his guitar configuration mark and registrant's guitar configuration mark. However, assuming that is the case<sup>10</sup>, the applicable test is likelihood of confusion, not actual confusion. See

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<sup>9</sup> The *Guitar World* articles made of record by applicant in support of his Section 2(f) claim include photographs of various third-party guitars. However, there is no basis in the record for concluding that the guitar configurations depicted in those photographs function as or are perceived as trademarks. The photographs therefore are not probative evidence of "similar marks in use on similar goods."

<sup>10</sup> We do not know whether registrant, who is not a party to this ex parte proceeding, is aware of any actual confusion.

*Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *Block Drug Co. v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989); and *Guardian Products Co. Inc. v. Scott Paper Co.*, 200 USPQ 738, 742 (TTAB 1978).

Furthermore, the purported absence of actual confusion is legally insignificant here, because we have no basis for finding that there has been any substantial opportunity for actual confusion to have occurred. See *Gillette Canada Inc. v. Ranir Corp.*, *supra*. The seventh and eighth *du Pont* factors accordingly are neutral in this case.

Applicant asserts that Paul Reed Smith, the owner of the cited registration, has encouraged applicant to seek registration of the guitar configuration and has informed applicant that he has no objection to issuance of such registration. Applicant argues that this constitutes evidence that confusion is unlikely. However, applicant's assertion as to what registrant told him is hearsay. No written consent agreement between applicant and registrant, nor any other documentary evidence pertinent to the tenth *du Pont* factor ("market interface"), has been made of record, and that factor accordingly is neutral in this case. See *In re Opus One Inc.*, *supra*, 60 USPQ2d at 1822.

Finally, we turn to the first *du Pont* factor, which requires us to determine whether applicant's mark and

opposer's mark, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. Because the marks involved in this case are product configurations which, by their nature, have no pronounceable sound or meaningful connotation, our finding under the first *du Pont* factor necessarily rests on a visual comparison of the respective marks. Cf. *In re Burndy Corporation*, 300 F.2d 938, 133 USPQ 196 (CCPA 1962); *Daimler-Benz Aktiengesellschaft v. Chrysler Corporation*, 169 USPQ 686 (TTAB 1971).

In making that comparison in this case, as in any case, the following general principles apply. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark

may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698 (Fed. Cir. 1992).

The Trademark Examining Attorney contends that applicant's and registrant's respective guitar configuration marks are similar in terms of their appearance and overall commercial impression, in that both guitar bodies have rounded bottom curves and two curved horns at the top. Given the identical nature of the goods, the Trademark Examining Attorney argues, these similarities between the marks are sufficient to cause a likelihood of confusion.

For his part, applicant argues that there are significant visual differences between the two guitar configurations which outweigh the similarities cited by the Trademark Examining Attorney and which negate any confusing similarity between the marks. Specifically, applicant

argues in his brief that: (a) the left horn of his guitar is much longer and more pronounced than the left horn of registrant's guitar; (b) the right, smaller horn of applicant's guitar turns up and then flares out, whereas the right horn of registrant's guitar merely turns up; (c) applicant's guitar features a much greater angle between the horns where the neck attaches to the guitar body; (d) applicant's guitar is physically bigger than registrant's guitar, except at the waist; (e) the waist of applicant's guitar is more pinched and narrow than the waist of registrant's guitar; (f) applicant's guitar body is asymmetrical, whereas registrant's guitar body is symmetrical; and (g) due to its asymmetrical body, the bottom curve of applicant's guitar is angular and aggressive, rather than the balanced bottom curve of registrant's guitar.

Applicant has submitted twelve identical form statements, unsworn, from persons identified as professional musicians and/or employees of guitar retailers. The statements include side-by-side frontal photographs of the two guitars, and the following text: "The Driskill Diablo guitar does NOT look similar to a Paul Reed Smith guitar. The major differences between the unique Driskill guitar and the PRS guitar being..." There

then follows the same enumeration of purported differences between the two guitars as is set forth in applicant's brief and recounted in the preceding paragraph of this opinion, *supra*.

Applicant also has submitted (as part of Exhibit C to his request for reconsideration) a copy of a "To Whom It May Concern" e-mail message (unsworn) from Tony Orifici, one of the persons who signed the above-referenced form statement. In pertinent part, Mr. Orifici asserts that: he is, and has been, a full-time professional musician for the past thirty years; his instrument is the guitar, and his specialty is Concert/Session work; that his "main guitars are a custom made 'Driskill' and a Paul Reed Smith;" and that over the years he has owned and played many guitars, including "Fender Strats, Teles, Gibson Les Paul and Guild SG's to name a few." He states, "So I know guitars and I know what I like and need for my signature sound." He further states:

I wish to clarify that my Driskill Guitar is a stand alone hybrid model and is not a "copy" of a Paul Reed Smith. They are two completely different instruments. As stated, I own one of each.

Cosmetically, the head stock, cutaways, fingerboard inlays and body shape of my Driskill guitar are totally different from my Paul Reed Smith. One only has to look at the two guitars side by side to see this.



Controls: My Driskill guitar's controls were built to my requirements. The volume and Tone knobs are lower on the body than my PRS, and I have a 5 way selector switch, ala stratocaster, rather than the 5 way rotary knob on my PRS. Pick-ups: My PRS model is a Custom 24 with a 10 top and stock PRS pick-ups. My Driskill guitar is equipped with "Seymour Duncan Jeff Beck model humbuckers." The guitars sound completely different from one another. If I wanted a guitar that had the same sound as my PRS, I would have bought another PRS!

To say that my Driskill guitar is a "clone" in any way of my PRS guitar is completely without merit. They are two excellent instruments and perform exactly as I expect them to. Flawlessly. I have owned my PRS for 5 years now, and my Driskill for a little more than a year. I have no need of any more guitars.

My PRS is not from a Custom Shop, but the Driskill was built to my specifications from scratch. I couldn't be happier with the guitar. And I say again... it is not a copy or clone of my Paul Reed Smith. To say it is compares apples and oranges in my opinion.

With respect to applicant's list of visual points of distinction between the two product configurations, as set forth in applicant's brief and in the statements from musicians and retailers submitted by applicant, the Trademark Examining Attorney argues that only one of those distinctions is relevant to our comparison of the marks, i.e., the fact that the right horn on applicant's guitar turns up and then flares out, while the right horn on registrant's guitar merely turns up. He argues that the other points of distinction identified by applicant, while

perhaps apparent from a comparison of the actual guitars or photographs thereof, are not apparent from the drawings of the marks in the application and registration, and that they therefore are irrelevant to our likelihood of confusion determination.

In his reply brief, applicant responds to this argument by contending that because the marks involved here are the actual goods as they exist in three dimensions, our comparison of the marks for likelihood of confusion purposes should not necessarily derive solely from the manner in which the goods are illustrated in the drawings, but should also take into account the goods as they actually are configured. He also argues that if any of the specific points of distinction between the two guitar shapes he relies upon, i.e., differences in the curvatures of the horns, the sizes of the waists, and the symmetry or asymmetry of the bodies, are not apparent from the drawings, it is only because the drawing in the cited registration is insufficiently clear and definite in its depiction of these specific details of the configuration of registrant's guitar; applicant contends that he should not be penalized for, nor should his arguments limited by, the asserted deficiencies in registrant's drawing.

However, we need not and do not reach the issue of whether, as the Trademark Examining Attorney argues, our comparison of the marks must be limited to the marks as depicted in the application and registration drawings, or whether instead, as applicant argues, we may and should consider the photographic depictions of the guitars as well.<sup>11</sup> This is because our decision in this case would be the same either way.

That is, even considering the photographs of the guitars and not just the application and registration drawings, and taking into account the specific differences between the two guitar configurations that applicant argues are apparent from the photographs, we nonetheless find that those differences are too subtle and minor to adequately distinguish the two configurations except when they are compared side-by-side. As noted above, the test for likelihood of confusion is not whether the marks can be

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<sup>11</sup> We are aware of no Board precedent on this issue, i.e., whether our comparison of two product configuration marks under the first *du Pont* factor must be limited to consideration of the marks as they are depicted in the application and registration drawings. Indeed, we are aware of no precedential Board decisions (either *ex parte* or *inter partes*) in which the asserted ground for refusal of registration (or ground for opposition to or cancellation of registration) was the one involved in this case, i.e., likelihood of confusion as between two product configuration marks.

distinguished in a side-by-side comparison.<sup>12</sup> Rather, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, *supra*.

For this reason, we accord very little probative value to the form statements submitted by applicant; the side-by-side comparison upon which the persons signing the statements base their enumeration of the differences between the two guitar configurations is not helpful to our likelihood of confusion determination in this case. Additionally, even if these statements were of more probative value than they are, we still would be obliged to reach our own considered decision as to the visual similarity or dissimilarity of the two configurations; the opinions of the persons who signed the statements are not binding on us, nor ought we to accept them uncritically. See *Quaker Oats Co. v. St. Joe Processing Co., Inc.*, 109 USPQ 390, 391 (CCPA 1956); *Youngstown Sheet and Tube Company v. Armco Steel Corporation*, 170 USPQ 162, 165 (TTAB 1971).

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<sup>12</sup> There is no evidence in the record to support applicant's argument, at footnote 12 of his brief, that guitar purchasers normally engage in side-by-side comparisons of competing models.

We also find that the above-excerpted letter from Tony Orifici is of little probative value on the issue of whether the two guitar body configurations are confusingly similar. First, in his detailed comparison of the two guitars, the alleged difference in "body shape" is only mentioned in passing, and then only in conjunction with other "cosmetic" differences ("the head stock, cutaways, fingerboard inlays") which are irrelevant to our analysis. Moreover, like the signers of the form statements, Mr. Orifici unhelpfully bases his observations on a side-by-side comparison of the two guitars: "One only has to look at the two guitars side by side to see this." It also is apparent that Mr. Orifici's ability to distinguish between the two guitars is based, in large part, on the functional and technical differences between the guitars, i.e., on the differences in their respective controls and pick-ups, and most importantly on the differences in the sound of the two guitars: "I know what I like and need for my signature sound... The guitars sound completely different from one another. If I wanted a guitar that had the same sound as my PRS, I would have bought another PRS!" Mr. Orifici's contention that applicant's guitar is not a "clone" or "copy" of the Paul Reed Smith guitar likewise is beside the point in this case; the issue is whether the configurations

are confusingly similar, not whether applicant's guitar is a "clone" or "copy" of the Paul Reed Smith guitar.

We have carefully considered the evidence of record, and we conclude that the two configuration marks at issue here are similar, rather than dissimilar, under the first *du Pont* factor. We find that the overall, general similarities in the two guitar configurations are more significant and likely to be recalled by purchasers than are the specific, subtle differences between the two configurations. For example, we find that purchasers are more likely to perceive and recall that both guitars feature a prominent and elongated left horn; they are less likely to perceive and recall the subtle differences in the shapes and lengths of the respective left horns.<sup>13</sup>

Moreover, as noted above, because applicant's goods, trade channels and classes of customers are legally identical to those of registrant's, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is lessened. *Century 21 Real Estate Corp. v. Century Life of America, supra*. We find that the marks are

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<sup>13</sup> And, as discussed above in connection with the acquired distinctiveness refusal, no evidence is of record in this case from which we could conclude that guitarists typically or generally look to the shape of a guitar body, per se, as a source-indicator, or that they are accustomed to distinguishing as to source on the basis of such minor and subtle differences between the shapes of guitars as those applicant relies on.

sufficiently similar that confusion is likely to result from their use in connection with these identical goods, and that the first *du Pont* factor accordingly weighs against applicant in this case.

Having carefully considered all of the evidence of record pertaining to the *du Pont* likelihood of confusion factors, we conclude that a likelihood of confusion exists, and that registration of applicant's mark accordingly is barred by Section 2(d). Any doubts we might otherwise have as to the existence of a likelihood of confusion must be resolved against applicant and in favor of the prior registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

In summary, we have carefully considered all of the evidence of record and all of applicant's arguments in opposition to the Trademark Examining Attorney's refusals to register (including any arguments not explicitly discussed in this opinion), and we are persuaded that the refusals are proper.

**Decision:** The Section 2(d) refusal, and the non-distinctiveness refusal under Sections 1, 2, 45, and 2(f), are **affirmed**.